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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/271,502 | 03/18/1999 | TAKASHI HONDA | 450100-4811 | 4228 |

20999 7590 01/17/2007
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745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

CHEVALIER, ROBERT

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2621

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/271,502

Applicant(s)

HONDA, TAKASHI

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 37-43 and 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 37-43 and 54-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-10, 13-14, 37-39, 42-43, 54-55, 57-58, 60-61, 63-64, 66-67, and 69, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami in view of Higuchi et al and Mac Cormack et al (P.N. 6,144,797) as set forth in the previous Office Action mailed out on 8/14/06.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (US 2002/0033888 A1) in view of Higuchi et al, MacCormack et al, as applied to claims 1, and 5, above, and further in view of Spitzer et al (US 2001/0012067) as set forth in the previous Office Action mailed out on 8/14/06.

4. Claims 11-12, 40-41, 56, 59, 62, 65, and 68, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (US 2002/0033888 A1) in view of Higuchi et al, MacCormack et al, as applied to claims 1, and 37 above, and further in view of Hong (US Patent No. 5,257,142) as set forth in the previous Office Action mailed out on 8/14/06.

Response to Arguments

5. Applicant's arguments filed 11/14/06 have been fully considered but they are not persuasive.

Regarding the Applicant's argument in that the proposed combination of Yamagami, Higuchi, Spitzer, and Hong indicated in the above rejection fails to disclose the claimed feature of "while the image data recorded on the first recording medium is reproduced and displayed on the display means, the selecting means allows a user to select either one image data or collective the image data recorded on said first recording medium to be transferred to said second recording medium, wherein the image data recorded on the first recording medium includes single image data, dynamic image data, an index of single image data, and an index of dynamic image data", Examiner disagrees. It is noted that, as indicated in the previous Office Action, such a feature of "reproducing the image data from the first recording medium and displaying the same on a display means while the user selects either one image or collective image data from the first recording medium to be transferred to the second recording medium" is present in the proposed combination of Yamagami, Higuchi et al and MacCormack et al indicated above. Because, when the proposed combination of Yamagami and Higuchi et al is modified in a manner to incorporate the MacCormack et al's video recording/reproducing apparatus for the reason indicated in the above rejection, such a claimed feature argued by Applicant would be present in the proposed combination of Yamagami, Higuchi et al, and MacCormack et al. Since, MacCormack et al clearly discloses the capability reproducing and displaying the image data recorded on the first recording medium while allowing the user to select one image data or collective image data recorded on the first recording medium to be transferred to the

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second recording medium. Applicant's attention is directed to MacCormack et al's claim 2.

It is further to be noted that the claimed feature of recording index data for the recorded image data also argued by Applicant is present in the proposed combination of Yamagami, Higuchi et al, and MacCormack et al. Applicant's attention is directed to Yamagami's claims 11, and 17, where it is disclosed the capability of recording image name, and attribute information with the recording of the image data.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Chevalier
January 10, 2007.


ROBERT CHEVALIER
PRIMARY EXAMINER